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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/047,123
Filing Date: January 15, 2002
Appellant(s): BODIN, WILLIAM KRESS

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 March 2006 appealing from the Office action mailed 20 October 2005.

1. ***Real Party in Interest***

A statement identifying the real party in interest is contained within the brief.

2. ***Related Appeals and Interferences***

A statement indicating Applicant is unaware of any related appeals or interferences is contained within the brief.

3. ***Status of Claims***

The statement of the status of the claims contained within the brief is correct.

4. ***Status of Amendments***

The Appellant's statement of the status of amendments after final rejection contained within the brief is correct.

5. ***Summary of Claimed Subject Matter***

The summary of the invention contained within the brief is correct.

6. ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9, 10, 21, 22, 33, 34, 45 & 46 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-50 are rejected under 35 U.S.C. § 103(a) over the combined teachings of Butler and Skinner.

The above-noted rejections are set forth in a prior Office Action, mailed on 20 October 2005. The prior Office Action is included herein below:

Claim Rejections - 35 USC § 112

1. Claims 9, 10, 21, 22, 33, 34, 45 & 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, Examiner finds the wording "in near real time" to be indefinite. Proper amendment of the same is required. For purposes of Examination, "in near real time" will be interpreted to mean "immediately". Examiner is not persuaded by Applicant's remarks, and further notes that the terminology "almost immediately" and "promptly", as noted within the specification, is also indefinite. Moreover, Examiner finds that within a computer, actions take place at a level unperceivable to a human being, and as such, time must be clearly defined. Thus, Examiner requires removal of the "in near real time" language, again interpreting the same to mean "immediately". Additionally, Examiner notes a typo in the specification, (p. 21, line 26), as the word "even" is likely meant to read "event".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent US 6,584,493 B1 to Butler in view of US Patent US 6,721,740 B1 to Skinner.

4. Regarding Claims 1, 13, 25 & 37, Butler discloses a method, system and computer program product for ad hoc data sharing, (Abstract; Figs 2a-c; Col. 4, lines 29-67; Cols. 5-6; Col. 7, lines 1-21; Col. 10, lines 5-59), comprising:

- each user has a client device, (Figs 2a-c);
- at least two of the client devices are (wirelessly) coupled for data communications to at least one computer, (Col. 6, lines 22-35), (Examiner notes that Butler teaches clients "remote" from the host, which clients could obviously be wireless, however; Examiner cites Skinner below for additional clarification);
- receiving from client devices digital asset records representing digital assets, (application(s)), (Col. 5, lines 39-49);
- displaying the retrieved digital assets, (Fig. 1; Col. 8, lines 48-50; Col. 10, lines 5-45); and
- editing one or more of the retrieved digital assets, (Col. 5, lines 39-49 & Col. 10, lines 5-45), (Examiner notes that a collaboration process obviously include some form of editing functionality).

5. Though Butler specifically teaches a multiparty conferencing and collaboration system, obviously capable of being implemented on a Unix operating system, (and

moreover, implemented on a Microsoft system, which system also obviously incorporates a permissions functionality – particularly for control of shared applications – (Abstract)), Butler does not specifically enumerate the use of permissions within a database format. Though, again Examiner finds that the use of a database format within a conferencing/collaboration structure is obvious for proper tracking and distribution of information, particularly sensitive information requiring special access privileges.

6. That noted, Examiner cites Skinner which provides a relational database server in conjunction with a permission functionality, (Skinner - Col.16, lines 66-67; Col. 17, lines 1-28; & Col. 18, lines 45-48), wherein at least one user record is obviously created representing a user granted access to digital assets, wherein each user record obviously composes a user access privilege field identifying for each user that user's user access privilege for access to digital assets; at least one asset access permission field identifying a digital asset's asset access permission, each distal asset record comprising: a location field identifying the location of a digital asset; retrieving digital assets in dependence upon the location fields in the digital asset records; and wherein the editing is carried out in dependence upon user access privilege and in dependence upon asset access permission, (as the ability to edit is obviously based on the ability to access).

7. It would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the permission and database functionalities of Skinner within the Butler structure as noted within Skinner which teaches enterprise

applications, (Butler), wherein multiple users may each access the application and the enterprise data at the same time as well as see the effects of the modifications, (edits), immediately, (Skinner - Col. 1, lines 47-64). Thus, given a collaboration/conferencing system with an access control functionality, (Butler – Col. 22, lines 58-60), such as that of Butler, it would be obvious to organize, control and allow access to data in a reliable efficient manner, thus avoiding unauthorized conference or collaboration participant access to sensitive material. In other words, within a conferencing/collaboration structure, it would have been obvious, (and necessary) to organize both user and data access privileges and locations within a database comprising multiple "records", one for each user and piece of data, such that collaborating/conferencing concerning the same could be easily organized and executed. Additionally, Examiner notes that Skinner teaches an active update notification for updating interested clients and/or servers, (Skinner – Abstract), and which updating functionality would obviously be needed within a collaboration system, such as that of Butler, for purposes of providing all collaborating parties to the most current and up-to-date information.

8. Further, as noted herein above, Butler teaches "remote" clients, however; Butler does not specifically teach "wireless" clients. Skinner specifically teaches a Remote Method Invocation, (Col. 2, lines 34-39 & Col. 16, lines 38-45), wherein wireless network communication is also possible, (Col. 4, lines 52-67). Thus, Claims 1, 13, 25 & 37 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

9. Regarding Claims 2, 14, 26 & 38, Butler in view of Skinner is relied upon for those teachings noted herein. As noted above, Skinner teaches a relational database management system, (Col. 17, lines 14-28 & Col. 18, lines 45-48), wherein inclusion of a specific group table, associated group/user record(s), group access privilege field, (identifying access privileges for users represented by the related user records), and a foreign key field, (identifying a one-to-many relationship between the group table and one or more related user records in the user table) would have been obvious as part of the well-known structure of a relational database, (i.e.: MS Access), and further for purposes of identifying user/members with access to specific data, as noted herein above. Thus, Claims 2, 14, 26 & 38 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

10. Regarding Claims 3, 15, 27 & 39, Butler in view of Skinner is relied upon for those teachings noted herein. As noted above, Skinner teaches privileges, which privileges are well-known in the art to include read, write and execute functionalities. Additionally, Examiner notes Applicants admission of the same with regard to the well-known Unix operating system, (specification, p. 19, lines 9-15). Thus, Claims 3, 15, 27 & 39 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

11. Regarding Claims 4-6, 11, 16-18, 23, 28-30, 35, 40-42 & 47, Butler in view of Skinner is relied upon for those teachings noted herein. As noted above, Skinner teaches client devices wirelessly coupled for data communications to the computer through a service gateway, (per pending Claims 4, 11, 16, 23, 28, 35, 40 & 47), through

a Bluetooth piconet, (per pending Claims 5, 7, 29 & 41), or 802.11(b) connection, (per pending Claim 6, 18, 30 & 42). Examiner notes that wireless communication obviously includes Bluetooth piconet and 802.11(b) connection(s), as the same are well-known types of wireless connections. Thus, Claims 4-6, 11, 16-18, 23, 28-30, 35, 40-42 & 47 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

12. Regarding Claims 7, 8, 19, 20, 31, 32, 43 & 44, Butler in view of Skinner is relied upon for those teachings noted herein. Additionally, Butler teaches a unique controller ID, (Col. 22, lines 58-60), which ID is used to identify the user and would obviously include a password for user verification purposes, (per pending Claims 7, 19, 31 & 43). Moreover, as noted above, Skinner and Butler both teach manipulation of data by multiple users, wherein each digital asset record would obviously comprise a digital asset identification field, an owner identification field, and an asset relationship field identifying relationships among digital assets for purposes of identifying the proper digital asset in addition to proper permissions to access the same, (per pending Claims 8, 20, 32 & 44). Thus, Claims 7, 8, 19, 20, 31, 32, 43 & 44 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

13. Regarding Claims 9, 10, 21, 22, 33, 34, 45 & 46, Butler in view of Skinner is relied upon for those teachings noted herein. Additionally, as noted herein, Skinner teaches changing permissions, which changing obviously, (if not inherently), includes:

receiving from a first client device a first digital asset record representing a first digital asset, the first digital asset record comprising a first asset access permission field identifying a first asset access permission;

and receiving from the first client device a second digital asset record representing the first digital asset, the second digital asset record composing the first asset access permission field identifying a second asset access permission;

replacing, promptly after receiving the second digital asset record, the first digital asset record with the second digital asset record;

whereby the asset access permission for the digital asset is changed (immediately) from the first asset access permission to the second asset access permission. Thus, Claims 9, 10, 21, 22, 33, 34, 45 & 46 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

14. Regarding Claims 12, 24, 36 & 48, Butler in view of Skinner is relied upon for those teachings noted herein. Additionally, as noted herein, Skinner teaches a relational database management system, which system would obviously include the steps of creating a user group table and receiving digital asset records are carried out upon a (staging) computer and the steps of retrieving, displaying, and editing are carried out upon a (project) computer, the method comprising the further step of displaying on at least one computer display device of the staging computer the retrieved digital assets in their unedited form. Examiner notes that using separate computers for database creating and viewing would be obvious in a database management system which often includes an administrator, (server), for creation of the database, and a client for viewing the same. Moreover, Examiner notes that in creating the database, it is obviously necessary to be able to view the same in its unedited form for purposes of information

verification. Thus, Claims 12, 24, 36 & 48 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

15. Regarding Claims 49 & 50, Butler in view of Skinner is relied upon for those teachings noted herein. Additionally, as noted herein, Butler discloses computer display devices, (Fig.1), which devices obviously comprise projectors and projection screens, (per pending Claim 49), and video displays, (per pending Claim 50). Thus, Claims 49 & 50 are found to be unpatentable over the combined teachings of Butler in view of Skinner.

7. *Response to Arguments*

7.1 Claims 9, 10, 21, 22, 33, 34, 45 & 46

7.1 The wording "in near real time" is in fact indefinite, (Appeal Brief, p. 10)

Appellant argues that the wording "in near real time" is not indefinite, noting Examiner's interpretation of "immediately" to be inadequate in light of the definition provided within Appellant's specification, which definition Examiner found to be equally inadequate and contradictory. Appellant defines "in near real time" to mean, "that an event occurs promptly, or almost immediately, from the perspective of a human being", (Appellant specification p.21, lines 25-27). Examiner specifically chose the interpretation "immediately" from a reading of Appellant's definition. Examiner realizes that a claim should be interpreted according to the meaning as defined within the specification; however, when said definition provides inadequate guidance as to a

meaning because it is open to more than one conflicting interpretation, (as in this case), Examiner has no choice but to interpret the claim language in light of what the Examiner believes to be Appellant's intended teachings.

In this case, Miriam-Webster defines the word "promptly" to mean, "performed readily or immediately", and thus, Appellant's own definition is contradictory in that an event occurring "immediately" is inherently different from an event occurring "almost immediately". Therefore, Examiner had no choice but to choose a definition for "in near real time" and to interpret the claims accordingly. Examiner chose the wording "immediately" because Examiner found the wording "almost immediately" equally indefinite. Because the wording "immediately" is a well-known dictionary-defined definition/synonym for the word "promptly", Examiner finds that interpretation of the claim language using the word "immediately" was indeed proper.

Appellant goes on to argue that 171 issued patents use the terms "near real time" in their claims, and Examiner responds by noting that applications are evaluated on a case-by-case basis. Moreover, knowing nothing of these other 171 issued patents, (as Appellant failed to note any specific instances within the proper context), Examiner could only hope that patent owners of the other 171 issued patents took the time to better define the intended meaning behind their use of the phrase "in near real time" so as to provide the public a proper framework by which to judge the scope of their issued patents.

Appellant's final argument regards the Newton's Telecom Dictionary definition of "in near real time" as "not quite in real time, but nearly so", which definition Examiner

again finds to be inadequate without further explanation and proper context. In this case, Examiner again emphasizes that the interpretation of "immediately" was adequate and proper within this context and for examination purposes, as noted herein above.

7. 2 The combined teachings of the Butler '493 patent and the Skinner '740 patent do in fact teach each and every element within Appellant's claims limitations, (Appeal Brief: p.13)

7.2.A. Butler does indeed teach, "each user has a client device", (Appeal Brief, p. 13).

Regarding Appellant's argument that Butler does not teach "each user has a client device", Examiner respectfully disagrees, as noted within the Office Action dated 20 October 2005, which reads:

> Regarding Applicant's argument that Butler does not teach, "each user has a client device", Examiner respectfully disagrees noting that Butler clearly teaches a multiparty conferencing and collaboration system which incorporates monitors or other types of display devices, (Fig. 1 & Col. 8, lines 53-65).

Specifically, Examiner notes that Butler clearly teaches a multiparty conferencing and collaboration system comprising a local personal computer specifically inclusive of a monitor or other type of display device, in addition to a remote computer(s), which remote computer(s) may also be a personal computer(s), and which personal computer(s) would also be specifically inclusive of a monitor or other type of display device. Thus, Examiner finds that Butler clearly teaches wherein "each user has a client device".

7.2.B. Butler does indeed teach, "receiving from client devices digital asset records representing digital assets" and "displaying the retrieved digital assets" (Appeal Brief, p. 14).

Regarding Appellant's argument that Butler does not teach "receiving from client devices digital asset records representing digital assets" and "displaying the retrieved digital assets", Examiner respectfully disagrees as noted within the Office Action dated 20 October 2005, which reads:

> Regarding Applicant's argument that Butler does not teach, "receiving from client devices digital asset records representing digital assets" and "displaying the retrieved digital assets", Examiner respectfully disagrees noting that Butler clearly teaches a collaboration model for application, (digital asset) sharing and display, (Col. 9, lines 53-67 & Col. 10, lines 1-44), in addition to monitoring/display devices, (Fig. 1 & Col. 8, lines 53-65).

Specifically, Examiner notes that Appellant's specification defines "digital assets" to include any document or computer file, (i.e.: application), capable of embodiment in digital form, including, for example, word processing documents and JPEG images, (Appellant's specification, p.13). Examiner notes that Butler clearly teaches a multiparty conferencing and collaboration system comprising the T.126 Multipoint still image and annotation protocol, which protocol "defines collaborative data sharing, including white board and image/digital asset sharing, graphic display information, and image exchange in a multipoint conference". Examiner finds that the sharing, (sending and receiving), of images/digital assets and graphic display information, clearly reads upon "receiving from client devices digital asset records representing digital assets".

Additionally, Appellant clearly admits that Butler teaches "when and whom relinquishment of shared application control occurs", (Appeal Brief, p. 14). Examiner notes that the relinquishing of shared application control, is clearly the relinquishment of

a digital asset, (the application/computer file), and the relinquishing of the digital asset to another clearly and obviously requires a sending by one party and a receiving by another party. Moreover, as noted herein, Butler clearly teaches a collaborative graphic data sharing multipoint conference wherein each member has a personal computer specifically inclusive of a monitor or other type of display device, which display device would clearly "display the retrieved digital assets", especially within a collaborative multimedia teleconferencing environment.

Examiner further notes that Butler clearly teaches, "editing one or more of the retrieved digital assets", as Butler teaches a collaboration system based on the NetMeeting® 3.0 software, which software is well-known in the art to include an editing functionality, (as noted within Newton's Telecom Dictionary, 18th Ed., Newton, Harry, CMP Books, Feb. 2002, p.502).

7.2.C. Skinner does indeed teach a database with access permissions as disclosed within the claim limitations of Appellant's application, (Appeal Brief, p. 15-16).

Regarding Appellant's argument that Skinner does not teach:

- creating at least one user record representing a user granted access to digital assets;
- each user record comprises a user access privilege field identifying for each user that user's user access privilege for access to digital assets;

- at least one asset access permission field identifying a digital asset's asset access permission;
- a location field identifying the location of a digital asset;
- retrieving digital assets in dependence upon the location fields in the digital asset records;
- and wherein the editing is carried out in dependence upon user access privilege and in dependence, (please note the wording "independence" is a typographical error within the Appeal Brief by Appellant on pp. 15 & 16), upon asset access permission.

Examiner respectfully disagrees as noted within as noted within the Office Action dated 20 October 2005, which reads:

> Regarding Applicant's argument that Skinner does not teach claim limitations specifically enumerating user record creation and asset access permissions, Examiner respectfully disagrees noting that Skinner clearly discloses a database with access permissions, wherein Applicant's specifically enumerated claim limitations would have been obvious as noted herein above.

Additionally, Appellant clearly admits that Skinner discloses the "idea of a database with access permissions", and a "permissions model for determining access permissions and change permissions for different clients or users", (Appeal brief, p. 15).

Moreover, the Microsoft Computer Dictionary, 5th Edition, Microsoft Press, 2002, clearly defines the following:

> access privileges - "the type of operations permitted a given user for a certain system resource on a network or a file server. A variety of operations, such as the ability to access the server, view the contents of the directory, open or transfer files, and create modify or delete files or directories"
>
> database - "a file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions"

Thus, taken individually, Examiner finds that Skinner (in view of Butler) does indeed teach each and every element of Appellant's claimed invention.

Specifically:

- creating at least one user record representing a user granted access to digital assets;
- (the Microsoft definition teaches "[user] records" as inherent to a database, Appellant admits that Skinner teaches a database with access permissions, and Butler clearly teaches access to digital assets);
- each user record comprises a user access privilege field identifying for each user that user's user access privilege for access to digital assets;
- (the Microsoft definitions teaches "[user] records, each containing fields together with a set of operations" as inherent to a database, and "access privileges" to inherently include "a variety of operations", Appellant admits that Skinner teaches a database with access permissions, and Butler clearly teaches access to digital assets);
- at least one asset access permission field identifying a digital asset's asset access permission;
- (the Microsoft definitions teaches "[user] records, each containing fields together with a set of operations for searching, sorting, recombining and other functions" as inherent to a database, and "access privileges" to inherently include "a variety of operations such as the ability to access the server, view the contents of the directory, open or transfer files, and create modify or

delete files or directories", and Appellant admits that Skinner teaches a database with access permissions, wherein within said database with access permissions, an access permission field would obviously serve to identify a digital asset's access permission for searching, sorting and recombining purposes);

- a location field identifying the location of a digital asset;
- (the Microsoft definitions teaches "[user] records, each containing fields together with a set of operations for searching/locating, sorting, recombining and other functions" as inherent to a database, and Appellant admits that Skinner teaches a database with access permissions, wherein a location field would obviously identify the location of digital assets within the database, (i.e.: during a search other function));
- retrieving digital assets in dependence upon the location fields in the digital asset records;
- (the Microsoft definitions teaches "[user] records, each containing fields together with a set of operations for searching/locating/retrieving, sorting, recombining and other functions" as inherent to a database, and Appellant admits that Skinner teaches a database with access permissions, wherein location field(s) would obviously identify the location of digital assets within the database thereby facilitating retrieval of the digital asset in dependence upon the location field within the digital asset record);

- and wherein the editing is carried out in dependence upon user access privilege and in dependence upon asset access permission;
- (the Microsoft definitions teaches "[user] records, each containing fields together with a set of operations for searching, sorting, recombining and other functions" as inherent to a database, and "access privileges" to inherently include "a variety of operations such as the ability to access the server, view the contents of the directory, open or transfer files, and create modify or delete files or directories", and Appellant admits that Skinner teaches a database with access permissions, wherein a user's ability to edit [data] within the database generally, is dictated by user database level access privileges. Moreover, additional layers of permission given to individual digital assets, (i.e.: for searching, sorting, etc.), clearly dictate the ability to edit the same regardless of the user's database level access. Thus, without proper permissions/privileges, on an individual user level in addition to on an individual digital asset level, a user would be unable to edit a digital asset. Thus a user's ability to edit a digital asset is dependent upon both user database level access privileges and individual digital asset permissions).

7. 3 Proper suggestion or motivation to combine Butler and Skinner does in fact exist, (Appeal Brief: p.16)

Regarding Appellant's argument that Butler does not teach proper suggestion or motivation to combine the teachings of Butler and Skinner, Examiner respectfully disagrees as noted within the Office Action dated 20 October 2005, which reads:

> In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, proper motivation to combine is noted herein above.
>
> In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Specifically, as noted herein above, it would have been obvious to one of ordinary skill in the art at the time of invention by Applicant to incorporate the permission and database functionalities of Skinner within the Butler structure as noted within Skinner which teaches enterprise applications, (Butler), wherein multiple users may each access the application and the enterprise data at the same time as well as see the effects of the modifications, (edits), immediately, (Skinner - Col. 1, lines 47-64). Thus, given a collaboration/conferencing system with an access control functionality, (Butler – Col. 22, lines 58-60), such as that of Butler, it would be obvious to organize, control and allow access to data in a reliable efficient manner, thus avoiding unauthorized conference or collaboration participant access to sensitive material.

In other words, within a conferencing/collaboration structure, it would have been obvious, (and necessary) to organize both user and data access privileges and locations within a database comprising multiple "records", one for each user and piece of data, such that collaborating/conferencing concerning the same could be easily organized and executed. Additionally, Examiner notes that Skinner teaches an active update notification for updating interested clients and/or servers, (Skinner – Abstract), and which updating functionality would obviously be needed within a collaboration system, such as that of Butler, for purposes of providing all collaborating parties to the most current and up-to-date information.

7. 4 Butler and Skinner are in fact analogous art, (Appeal Brief: p.17)

Regarding Appellant's argument that Butler and Skinner are nonanalogous art, Examiner respectfully disagrees as noted within the Office Action dated 20 October 2005, which reads:

> In response to applicant's argument that Butler and Skinner are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Examiner notes that it is the combination of the Butler and Skinner references which render Applicant's claimed invention unpatentable. Additionally, Examiner disagrees that the Butler and Skinner art would not be combinable reminding Applicant that it is a feature of the Skinner reference incorporated into the Butler reference which renders Applicant's claimed invention unpatentable.

Again, as noted herein above, Examiner finds the combined teachings of Butler and Skinner to clearly and obviously teach each and every element of Appellant's claimed invention.

7. 5 The combined teachings of Butler and Skinner would fact be successful, (Appeal Brief: p.18)

Regarding Appellant's argument that the combined teachings of Butler and Skinner would not be successful, Examiner respectfully disagrees, noting that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Specifically, Examiner again notes that it is merely certain features of the Skinner reference which are being relied upon, (for reasons noted herein above), for incorporation into the Butler multiparty conferencing and collaboration system, namely, the Skinner database, (with access permissions), and the Skinner active update notification functionality. Thus, the fact that Skinner teaches other functionalities, (i.e.: "periodic broadcast updates"), is irrelevant. Moreover, Examiner notes that update notifications periodically sent to more than one interested party at one time is still considered a "periodic broadcast update to an entire group".

7. 5 The Graham inquiries required for an obviousness rejection have in fact been properly considered, determined and applied, (Appeal Brief: p.19)

Regarding Appellant's argument that the Graham inquiries required for an obviousness rejection have not been properly considered, determined and applied, Examiner respectfully disagrees.

Appellant specifically relies on a misinterpretation of the law, noting that it was the responsibility of the Examiner to provide "evidence of secondary consideration", (Appeal Brief, p.21). Specifically, it is not Examiner's responsibility to provide "evidence of secondary consideration", as such evidence is rebuttal evidence, to be submitted by Applicant when replying to an office action, as noted respectively within MPEP § 609.05(c) and MPEP § 2141 as follows:

> **Documents Submitted as Part of Applicant's Reply to Office Action**
>
> Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication. To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action. However, consideration by the examiner of the document submitted as evidence directed to an issue of patentability raised in the Office action is limited to the portion of the document relied upon as rebuttal evidence; the entirety of the document may not necessarily be considered by the examiner.
>
> Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

As Appellant never submitted any rebuttal evidence in this case, (i.e.: long felt need in the art, inability to solve problem, etc.), Examiner had no such evidence of secondary consideration to evaluate.

7. 6 The Office Action does in fact ascertain the differences between the prior art and the claims in issue, (Appeal Brief: p.21)

Regarding Appellant's argument that the Office Action does not ascertain the differences between the prior art and the claims in issue, Examiner respectfully disagrees.

Again Appellant specifically relies on a misinterpretation of the law, noting, "in each office action, Examiner has only identified elements in Applicant's claims not found in Butler and then attempted to find a similar element in Skinner to support an obviousness rejection. Such analysis is improper and incomplete", (Appeal Brief, p.21).

The Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Clearly, as noted herein above, Examiner has properly analyzed and applied the Butler and Skinner prior art in light of Applicant's claimed invention, and has further found the same unpatentable.

7. 7 The Office Action does in fact resolve the level of ordinary skill in the pertinent art, (Appeal Brief: p.22)

Regarding Appellant's argument that the Office Action does not resolve the level of ordinary skill in the pertinent art, Examiner respectfully disagrees.

Appellant specifically notes that "in over four years of prosecution and in two Office Actions, no analysis at all considering the level of one of ordinary skill in the are for the instant case has been performed", (Appeal Brief, p.22). Examiner finds this statement nonsensical and quite late in its presentation. If Appellant did not believe that the inventors within the prior art had limited knowledge or understanding of the same, Appellant should have noted so earlier within the prosecution of this case.

Examiner finds that the inventors noted within the Butler and Skinner prior art do in fact equate to "one of ordinary skill in the art", and thus, the combined teachings of the Butler and Skinner art do in fact resolve the level of ordinary skill in the pertinent art at the time of invention by Appellant. Moreover, the combined teachings of Butler and Skinner do in fact teach each and every element of Appellant's claimed invention, rendering the same unpatentable.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Conferees

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